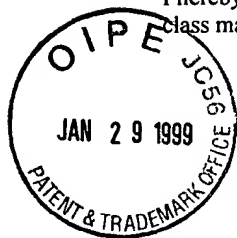


I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231, on January 27, 1999.



By:

Rebecca M. Whitelock
Rebecca M. Whitelock

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Siani et al.

Examiner: Not yet assigned

Serial No: 09/144,838

Art Unit: 1615

Filed: August 31, 1998

For: **MODULAR PROTEIN LIBRARIES AND METHODS OF PREPARATION**

Assistant Commissioner for Patents
Washington, D.C. 20231

FEB 02 1999

GROUP 180

Bel
2-19-99

TRANSMITTAL OF REFERENCES

Transmitted herewith are the following documents:

1. A copy of an Information Disclosure Statement Transmittal previously submitted on December 4, 1998
2. A copy of an Information Disclosure Statement and PTO form 1449 previously submitted on December 4, 1998
3. References Nos. F1, D1-D3, D5, D6, D8, D9, D11, D12, D14, D16-D31, D33-D36, D38-D45, D50-D56, D59, and D60 cited on PTO form 1449, not previously submitted. These references are being submitted under separate cover as stated on the enclosed copy of the Information Disclosure Statement.
4. Fee Transmittal
5. Return Receipt Postcard, postage prepaid


The Commissioner is hereby authorized to charge any underpayment of the following fees associated with this communication, including any necessary fees for extension of time, or credit any overpayment to Deposit Account No. 03-3117:

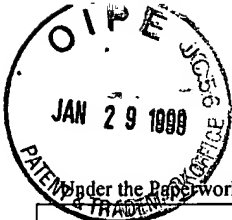
- ☒ Any national application filing fees under 37 CFR 1.16.
- ☒ Any patent application processing fees under 37 CFR 1.17.

Cooley Godward LLP
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306
Attn: Patent Group
Ph. (650) 843-5000
Fx. (650) 857-0663
JAB:BJW

Respectfully submitted,

COOLEY GODWARD LLP

By: 
James A. Bradburne, Ph.D.
Reg. No. 38,389



Approved for use through 9/30/000. OMB 0651-0032
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL

Note: Effective November 10, 1998.
Patent fees are subject to annual revision.

Complete if Known

| | |
|------------------------|------------------|
| Application Number | 09/144,838 |
| Filing Date | August 31, 1998 |
| First Named Inventor | Siani et al. |
| Group Art Unit | 1615 |
| Examiner Name | Not yet assigned |
| Attorney Docket Number | GRFN-020/01US |

TOTAL AMOUNT OF PAYMENT (\$)

METHOD OF PAYMENT (check one)

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:

Deposit Account Number: 03-3117
Deposit Account Name: Cooley Godward LLP

- ☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17
☐ Charge the Issue Fee Set in 37 CFR 1.18 at the Mailing of the Notice of Allowance

2. ☐ Payment Enclosed:
☐ Check ☐ Money Order ☐ Other

FEE CALCULATION

1. FILING FEE

| Large Fee Code | Entity Fee (\$) | Small Fee Code | Entity Fee (\$) | Fee Description | Fee Paid |
|----------------|-----------------|----------------|-----------------|------------------------|----------|
| 101 | 760 | 201 | 380 | Utility filing fee | |
| 106 | 310 | 206 | 155 | Design filing fee | |
| 107 | 480 | 207 | 240 | Plant filing fee | |
| 108 | 760 | 208 | 380 | Reissue filing fee | |
| 114 | 150 | 214 | 75 | Provisional filing fee | |
| SUBTOTAL (1) | | | | | (\$) |

2. CLAIMS

| | | | | | | |
|---------------------------|-------|-------|---|----------------|---|----------|
| Total Claims | -20 = | Extra | X | Fee from below | = | Fee Paid |
| Independent Claims | -3 = | | X | | = | |
| Multiple Dependent Claims | | | | | = | |

| Large Fee Code | Entity Fee (\$) | Small Fee Code | Entity Fee (\$) | Fee Description |
|----------------|-----------------|----------------|-----------------|---|
| 103 | 18 | 203 | 9 | Claims in excess of 20 |
| 102 | 78 | 202 | 39 | Independent claims in excess of 3 |
| 104 | 260 | 204 | 130 | Multiple dependent claim |
| 109 | 78 | 209 | 39 | Reissue independent claims over original patent |
| 110 | 18 | 210 | 9 | Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) (\$)

FEE CALCULATION (continued)

3. ADDITIONAL FEES

| Large Fee Code | Entity Fee (\$) | Small Fee Code | Entity Fee (\$) | Fee Description | Fee Paid |
|----------------|-----------------|----------------|-----------------|--|----------|
| 105 | 130 | 205 | 65 | Surcharge - late filing fee or oath | |
| 127 | 50 | 227 | 25 | Surcharge - late provisional filing fee or cover sheet. | |
| 139 | 130 | 139 | 130 | Non-English specification | |
| 147 | 2,520 | 147 | 2,520 | For filing a request for reexamination | |
| 112 | 920* | 112 | 920* | Requesting publication of SIR prior to Examiner action | |
| 113 | 1,840* | 113 | 1,840* | Requesting publication of SIR after Examiner action | |
| 115 | 110 | 215 | 55 | Extension for reply within first month | |
| 116 | 380 | 216 | 190 | Extension for reply within second month | |
| 117 | 870 | 217 | 435 | Extension for reply within third month | |
| 118 | 1,360 | 218 | 680 | Extension for reply within fourth month | |
| 128 | 1,850 | 228 | 925 | Extension for reply within fifth month | |
| 119 | 300 | 219 | 150 | Notice of Appeal | |
| 120 | 300 | 220 | 150 | Filing a brief in support of an appeal | |
| 121 | 260 | 221 | 130 | Request for oral hearing | |
| 138 | 1,510 | 138 | 1,510 | Petition to institute a public use proceeding | |
| 140 | 110 | 240 | 55 | Petition to revive - unavoidable | |
| 141 | 1,210 | 241 | 605 | Petition to revive - unintentional | |
| 142 | 1,210 | 242 | 605 | Utility issue fee (or reissue) | |
| 143 | 430 | 243 | 215 | Design issue fee | |
| 144 | 580 | 244 | 290 | Plant issue fee | |
| 122 | 130 | 122 | 130 | Petitions to the Commissioner | |
| 123 | 50 | 123 | 50 | Petitions related to provisional applications | |
| 126 | 240 | 126 | 240 | Submission of Information Disclosure Stmt | |
| 581 | 40 | 581 | 40 | Recording each patent assignment per property (times number of properties) | |
| 146 | 760 | 246 | 380 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 149 | 760 | 249 | 380 | For each additional invention to be examined (37 CFR 1.129(b)) | |

Other fee (specify) _____

Other fee (specify) _____

* Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)

SUBMITTED BY

| | | | |
|-----------------------|---------------------------|-------------------------|------------------|
| Typed or Printed Name | James A. Bradburne, Ph.D. | Reg. Number | 38,389 |
| Signature | | Date | January 27, 1999 |
| | | Deposit Account User ID | 03-3117 |

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231

Attorney Docket No: GRFN-020/01US

PATENT

COPY

Express Mail Label Number: EM100149058US

Date of Deposit:

December 4, 1998

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Patents, Box Sequence, Washington, D.C. 20231.

By:

Elaine Calimquim

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Michael A. Siani, et al.

Serial No.: 09/144,838

Examiner: Not yet assigned

Filed: August 31, 1998

Art Unit: 1615

For: MODULAR PROTEIN LIBRARIES AND METHODS OF PREPARATION

Assistant Commissioner for Patents
Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT TRANSMITTAL

1. Transmitted herewith is:

☒ Fee Transmittal

☒ Information Disclosure Statement

☒ PTO Form 1449

☒ Copies of references listed on the PTO form 1449:

☐ Copies of all listed references are enclosed.

☒ Copies of the following listed references are enclosed: F2-F9, D4, D7, D10, D13, D15, D32, D37, D44, D46-D49, D57, and D58.

☒ Copies of the following listed references are not enclosed and will be submitted under separate cover: F1, D1-D3, D5-D6, D8-D9, D11-D12, D14, D16-D31, D33-D36, D38-D43, D45, D50-D56, and D59-D60.

COPY

☒ Return Postcard Receipt, postage prepaid.

☐ English translation of foreign language reference(s)

☐ No copies of references listed on the PTO Form 1449 are being provided as this application claims continuation status to application Serial No. and copies of the listed references were provided in the parent application.

☐ Copy of foreign examination report

☐ English translation of foreign examination report

2. ☒ This Information Disclosure Statement is filed before the later of:

☐ three months from the filing date of this national application;

☐ three months from the date of entry of the national stage as set forth in 37 CFR 1.491 in an international application; or

☒ the mailing date of a first office action on the merits.

In accordance with 37 CFR 1.97(b), no fee is required.

3. ☐ This Information Disclosure Statement is filed after the events noted in paragraph 1, but before either:

☐ Final action under 37 CFR 1.113, or

☐ Notice of Allowance under 37 CFR 1.311.

In accordance with 37 CFR 1.97(c) also enclosed is:

☐ Fee under 37 CFR 1.17(p) in the amount of \$240.00; or

☐ Statement as stated below.

4. ☐ This Information Disclosure Statement is filed before the payment of the issue fee, but after either:

☐ Final action under 37 CFR 1.113, or

☐ Notice of Allowance under 37 CFR 1.311.

In accordance with 37 CFR 1.97(d) also enclosed is:

☐ Statement as specified in 37 CFR 1.97(e)

COPY

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COPY

- ☐ Petition requesting consideration of the Information Disclosure Statement; and
- ☐ The petition fee set forth in 37 CFR 1.17(i) in the amount of \$240.00.

5. Statement. The undersigned states:

- ☐ Each item of information contained in the Information Disclosure Statement cited herein was cited in a communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing date of this Information Disclosure Statement; or
- ☐ No item of information contained in the Information Disclosure Statement submitted herewith was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing date of this Information Disclosure Statement.

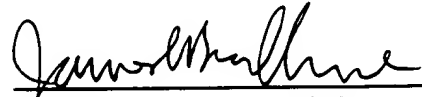
6. Fees

- ☐ Check in the amount of \$0.00 is attached.
- ☐ Please charge Deposit Account No. 03-3117 in the amount of \$0.00.
- ☒ No fee is required.
- ☒ The Commissioner is hereby authorized to charge any underpayment or credit any overpayment of the following fees associated with this communication to Deposit Account No. 03-3117:
 - ☒ Any patent application processing fees under 37 CFR 1.17.

Cooley Godward LLP
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Fax: (650) 857-0663
JAB:BJW

Respectfully submitted,
COOLEY GODWARD LLP

By:


James A. Bradburne, Ph.D.
Reg. No. 38,389

COPY

Attorney Docket No: GRFN-020/01US

COPY

PATENT

Express Mail Label Number: EM100149058US

Date of Deposit: December 4, 1998

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Patents, Box Sequence, Washington, D.C. 20231.

By:

Elaine Calimquim

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Michael A. Siani, et al.

Serial No.: 09/144,838

Examiner: Not yet assigned

Filed: August 31, 1998

Art Unit: 1615

For: MODULAR PROTEIN LIBRARIES AND METHODS OF PREPARATION

Assistant Commissioner for Patents
Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

Applicant hereby submits this Information Disclosure Statement in accordance with 37 CFR 1.98 and pursuant to Applicant's continuing duty under 37 CFR 1.56 to bring any information which may be material to patentability of this application to the Examiner's attention.

Applicant makes no representation that a search has been conducted by the Applicant, or that there is not possibly more relevant art. Applicant also makes no representation that the information submitted herewith is in fact material.

☐

No copies enclosed: The references listed on the enclosed Form PTO 1449 have been previously cited by or submitted to the PTO as recited in the Information Disclosure Statement Transmittal that accompanies this paper. In accordance with the provisions of 37 C.F.R. 1.98(d), no copies of these references are being provided.

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- ☒ Copies enclosed: Copies of the following references listed on the enclosed Form PTO 1449 are being provided with this Information Disclosure Statement: F2-F9, D4, D7, D10, D13, D15, D32, D37, D44, D46-D49, D57, and D58.
- ☒ Copies not enclosed: Copies of the following references listed on the enclosed Form 1449 are not being provided with this Information Disclosure Statement, copies of these references will be forwarded under separate cover: F1, D1-D3, D5-D6, D8-D9, D11-D12, D14, D16-D31, D33-D36, D38-D43, D45, D50-D56, and D59-D60.
- ☐ The enclosed references were cited in a foreign examination report in a related case. A copy of the search report and the cited references are attached hereto.
- ☐ The search report is not in the English language and a translation of the search report is enclosed.
- ☐ At least one of the enclosed references is not in the English language.
- ☐ English translation(s) are enclosed.
- ☐ Enclosed is an explanation of the relevance of non-English references for which an English translation is not available.
- ☐ The explanation is in the form of an English language search report.

The subject application is believed patentable over any of the above references.


Cooley Godward LLP
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Palo Alto, CA 94306-2155
Tel: (650) 843-5000
Fax: (650) 857-0663

JAB:

Enclosures: 1. Form PTO 1449
2. Copies of the following listed references F2-F9, D4, D7, D10, D13, D15, D32, D37, D44, D46-49, D57, and D58 cited on Form PTO-1449

Respectfully submitted,
COOLEY GODWARD LLP

By:


James A. Bradburne, Ph.D.
Reg. No. 38,389

COPY